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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES F. DESMOND

Appeal 2009-000529
Application 10/718,361
Technology Center 3700

Decided: September 18, 2009

Before JENNIFER D. BAHR, MICHAEL W. O'NEILL, and STEFAN
STAICOVICI, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

James F. Desmond (Appellant) seeks our review under 35 U.S.C.
§ 134 of the second non-final rejection of claims 16-28, 30-32, 47, 53-55,

57, and 61. Claims 1-15, 29, 33-46, 48-52, 56, 58-60 are canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The Invention

The claimed invention is to a system for transferring small amounts of lotions, shampoos, creams, and liquid medicines into flexible tubes.

Claim 47, reproduced below, is representative of the subject matter on appeal.

An adapter element system kit, for assisting pouring of a flowable substance from at least one first container comprising at least one first threaded opening to at least one second container having at least one second threaded opening, comprising:

- a) at least one adapter cap comprising at least one Yorker tip;
- b) wherein said at least one adapter cap is structured and arranged to connect to the at least one first threaded opening of the at least one first container;
- c) at least one receiving adapter comprising at least one access structured and arranged to flowably connect with said at least one Yorker tip of said at least one adapter cap;
- d) wherein said at least one receiving adapter comprises at least one threaded port structured and arranged to connect with said at least one second opening of said at least one second container; and
- e) the at least one second container;^[1]
- f) wherein said at least one receiving adapter is structured and arranged so that the flowable

¹ The extensive amendments made to this claim have caused this phrase to no longer further limit the second container.

substance may be transferred through said at least one adapter cap connected to said at least one receiving adapter directly from the at least one first container to said at least one second container;

g) wherein said at least one second container comprises at least one flexible squeeze-tube.

Claim Appendix, emphasis added.

The Prior Art

The Examiner relies upon the following as evidence of unpatentability:

Krstovic	US 5,285,824	Feb. 15, 1994
Borden	US 5,918,650	Jul. 6, 1999

The Rejections

The following Examiner's rejections are before us for review:

Claims 25-28, 47, 53, 55, and 57 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Borden.

The Examiner finds because container 38 is made of plastic it is capable of being a flexible squeeze tube. Ans. 5.

Claims 16-24, 30-32, 54, and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Borden.

The Examiner concludes it would be obvious to duplicate the parts of the claimed receiving elements, second containers, and flexible squeeze tubes disclosed in Borden and it is an obvious design choice to provide Borden with a travel bag to hold the duplicate parts. Ans. 6.

Claims 16-28, 30-32, 47, 53-55, 57, and 61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Borden and Krstovic.

The Examiner finds Borden does not disclose a flexible squeeze tube.
Ans. 9. The Examiner finds Krstovic teaches a flexible squeeze tube. *Id.*
The Examiner concludes it would be obvious to substitute Krstovic's flexible plastic bag container for the container 38 disclosed in Borden in order to make it easier to transfer material from one container to the other by squeezing. *Id.*

SUMMARY OF DECISION

We AFFIRM.

OPINION

Issues

There are two dispositive issues before us:

1) Is it error on the part of the Examiner to find that Borden anticipates the subject matter of claim 47 based on a finding that because Borden's bottle 38 could be made of plastic it is capable of being a flexible squeeze tube?

2) Is it error on the part of the Examiner to find Krstovic teaches a structure that satisfies the claimed subject matter "wherein said at least one second container comprises at least one flexible squeeze-tube?"

Anticipation based on Borden – Issue (1)

Facts Pertinent to Issues (1) & (2)

1. Borden does not explicitly disclose bottle 38 (container 38, Examiner's nomenclature) is flexible.

2. Borden explicitly discloses “[c]onsumers today pay considerable sums of money for shampoos, liquid cleaning detergents, perfumes and other liquid products generally contained within glass or plastic bottles.” Col. 1, ll. 12-15.
3. Not all plastic articles are flexible.

Principles of Law to Issue (1)

“Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)). “If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not § 102 anticipation, but § 103 obviousness.” *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1577 (Fed. Cir. 1991).

Analysis for Issue (1)

Borden does not explicitly disclose that bottle 38 is a flexible squeeze-tube. Fact 1. Borden explicitly discloses that bottles consumers want to transfer liquids to and from are made from glass or plastic. Fact 2. Therefore, the bottle 38 disclosed in Borden is made either from glass or plastic. A glass bottle is not a flexible squeeze tube. Not all plastic articles are necessarily flexible. Fact 3. Furthermore, not all plastic bottles are flexible squeeze tubes. Therefore, the claimed subject matter of the second container being a flexible squeeze-tube is not necessarily present in Borden. As such, the Examiner error in finding that Borden inherently anticipates this claimed feature.

Obviousness based on Borden

The Examiner's rejection of claims 16-24, 30-32, 54, and 61 is grounded in part on the Examiner's flawed finding that Borden discloses a second container comprising a flexible squeeze-tube. We are constrained not to sustain the rejection of claims 16-24, 30-32, 54, and 61 because the Examiner has articulated any reasoning as to why it would have been obvious to modify Borden to cure the deficiency identified above. *See Ans.* 6.

Obviousness based on Borden and Krstovic – Issue (2)

Additional Pertinent Facts for Issue (2)

4. Appellant's Specification describes the claimed second container as a flexible element means with a flat bottom means, a flexible bag, flexible tube, and a flexible squeeze-tube. *See Spec.* 13-14, 17-19, 22, 24 and figures 5, 7, 10, 19, 20, and 24.
5. Appellant's Specification describes where a person of ordinary skill in the art can acquire the needed items to make and use the invention:
 - a. non-spill spouts are available from Seaquist Closures. *Spec.* 14:12.
 - b. Yorker caps are available from Cleveland Bottle and Supply Co. *Spec.* 14:28-29.
 - c. a 60cc catheter syringe is available from Exel National. *Spec.* 16:9-10.
 - d. clips are available from John C Tucker Company, Fasteners for retail, and Rocky Mountain Cord Company. *Spec.* 22:4-5 and 9-12.

- e. bags are available from Kapak Corporation. Spec. 23:1.
 - f. squeeze tubes are available from JSN Packaging. Spec. 24:12.
 - g. squeeze tube fill-tops are available from Sequest Closures. Spec. 26:10-11.
 - h. “tottles” are available from Fenton, Weber & Jones. Spec. 26:17-18.
 - i. a sealing machine is available through www.aline.com. Spec. 27:30.
6. Krstovic teaches that container D may be a flexible plastic bag or a rigid container. Col. 2, ll. 36-38.

Principles of Law for Issue (2)

“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art.” *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (citations omitted).

When construing claim terminology in the United States Patent and Trademark Office, claims are to be given their broadest reasonable interpretation consistent with the specification, reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). We must be careful, however, not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enter., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by the explanations contained in the written

description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment”). “The [challenge] is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.” *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

“[T]he simple substitution of one known element for another” or “the mere application of a known technique to a piece of prior art ready for the improvement” generally will be obvious unless the substitution or the application of the known technique would have been beyond the level of ordinary skill in the art; or the results of the substitution or the application of the known technique would not have been predictable by one of ordinary skill in the art. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416-417 (2007).

Analysis for Issue (2)

The first step in the analysis is to properly construe the claimed subject matter “wherein said at least one second container comprises at least one flexible squeeze-tube.” The Specification provides multiple flexible embodiments for a person of ordinary skill in the art to interpret this claim limitation, viz. an element means with a flat bottom means, a bag, a tube, a squeeze-tube. Fact 4. “Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed Cir. 2004). In this case, the Specification’s listing of particular products, Fact 5, is not for limiting the scope of the claims, but for providing the enablement necessary to make

and use the claimed invention. Therefore, the broadest reasonable interpretation in light of the Specification for the claimed subject matter at issue is a flexible tube structure that is capable of being squeezed.

The second step in the analysis is to compare the properly construed claim to the prior art. The claim properly construed requires the art to teach a structure that can be considered a flexible tube with a capability of being squeezed. Krstovic teaches that its container can at least be a flexible bag. Fact 6. A flexible bag satisfies the claim subject matter properly construed in light of the specification, *viz.* a flexible tube structure that is capable of being squeezed. The bag structure itself satisfies the tube structure as Appellant's Specification uses that term, *viz.* a structure open at one end and sealed at the other. Krstovic's bag is taught as being flexible. A person of ordinary skill in the art would understand that a flexible bag is pliable. If the bag is pliable, then the bag would deform under pressure. Squeezing is a process of deforming an article under some pressure. Therefore, because the flexible bag will deform under pressure, it is likewise readily capable of being squeezed. Further, the replacement of Borden's bottle 38 that could be made of plastic, *see* Fact 2, with the flexible bag taught in Krstovic, *see* Fact 5, is a mere simple substitution of one known element for another that does not appear to be beyond the level of one of ordinary skill in the art. As such, the substitution is not beyond the skill level of a person having ordinary skill in the art or leading to some unexpected result. *KSR*, at 416-417.

Further, Borden's use of gravity to drain the contents of the first container into the contents of the second container does not teach away from Appellant's invention. Appellant's teaching away argument rests on two

assumptions: that 1) Borden second container is resting on a surface when the liquid is being transferred from the first container to the second container by gravity and 2) Borden second container is directly below the first container. However, nothing in Borden suggests such is occurring. There is no disclosure that Borden's transfer system could not be used with two containers held in mid-air. Further, there is nothing in Borden to suggest that the two containers could not be substantially the same plane. All that is required is the second container receive the liquid by a gravity draining technique. A gravity draining technique could be done with both containers held in mid-air by a person and could be done with a flexible bag as taught in Krstovic. A gravity draining technique could be done with both containers substantial on the same plane and the first container being opening being slightly above the second container's opening and could also be done with a flexible bag as taught in Krstovic. Thus, nothing in Borden precludes the second container from being flexible as taught by Krstovic. A person of ordinary skill in the art would readily appreciate flexibility in the second container because upon completion of the transfer of the liquid in the second container the contents of the second container would be easier to dispense by squeezing as the Examiner's reasoning alludes and would additionally achieve an objective of Borden which is completely dispense the remnants of the first container in order to prevent the throw-away of the remnants within the first container.

CONCLUSIONS

The Examiner erred in finding that Borden anticipates the subject matter of claim 47 based on a finding that because Borden's bottle 38 could be made of plastic it is capable of being a flexible squeeze tube.

The Examiner did not err in finding that Krstovic teaches a structure that satisfies the claimed subject matter "wherein said at least one second container comprises at least one flexible squeeze-tube."

DECISION

We REVERSE the Examiner's decision to reject claims 25-28, 47, 53, 55, and 57 under 35 U.S.C. § 102(b) as being anticipated by Borden.

We REVERSE the Examiner's decision to reject claims 16-24, 30-32, 54, and 61 under 35 U.S.C. § 103(a) as being unpatentable over Borden.

We AFFIRM the Examiner's decision to reject claims 16-28, 30-32, 47, 53-55, 57, and 61 under 35 § U.S.C. 103(a) as being unpatentable over Borden and Krstovic.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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Application 10/718,361

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